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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,545	04/20/2001	Paul Gilson	08157.0010	9270
7590 12/01/2004				
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			EXAMINER BAXTER, JESSICA R	
			ART UNIT 3731	PAPER NUMBER

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,545

Applicant(s)

GILSON ET AL.

Examiner

Jessica R Baxter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-34 and 68-72 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16-18, 26 and 69-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14, 15, 19-25, 28-34 and 68 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04162004, 06192002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Election/Restrictions***

1. Applicant's election of Species (1),(5),(6) in the reply filed on August 30, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 13, 16-18, 26 and 69-72 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 30, 2004.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-12, 14, 15, 20, 21, 24, 25, 28-34 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,371,971 to Tsugita et al.

Tsugita discloses an embolic protection system comprising: a guidewire (30) for advancing through a vasculature, the guidewire having a distal end and a proximal end; an embolic protection filter (filter 20) having a filter body with a distal end and a proximal end, the filter body having a plurality of openings at the distal end sized to allow through passage of blood, the filter body providing for a collapsed

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configuration and an expanded deployed configuration; the embolic protection filter body having a tubular guidewire path in isolation (FIG. 16B carriage, Column 15 lines 5-12) for slidably receiving the guidewire to permit movement of the filter relative to the guidewire when the filter is in the collapsed configuration and the expanded deployed configuration; a delivery catheter (sheath 105 mechanism 120) advanceable over the guidewire for delivery of the embolic protection filter; the delivery catheter having a proximal end and a distal end, the filter being deployed from the distal end of the delivery catheter into the expanded deployed configuration; a retrieval catheter (FIGS. 8-12E) advanceable over the guidewire for retrieval of the filter, the retrieval catheter having a distal end and a proximal end; and engagement elements (FIGS 8-11D elements 126, 130, 135, 140) for engaging the embolic protection filter with the guidewire for retrieval of the filter into the retrieval catheter in the collapsed configuration; the engagement elements comprising guidewire engagement elements that co-operate with engagement elements on the filter (FIGS. 8-11D elements 111, 131, 136, 141). Tsugita discloses a guide olive which tapers distally inwardly and is provided at the distal end of the filter body (FIGS. 16A and 16B distal end 112).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsugita et al '971 in view of U.S. Patent No. 5,954,745 to Gertler et al.

Tsugita discloses the claimed invention except for the releasable locking means comprising a tether. Gertler teaches that a tether may be attached to a filter to collapse and then retrieve the filter into a retrieval catheter (Column 9 lines 37-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Tsugita with a tether line as an alternate way of collapsing and retrieving the filter.

7. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsugita et al. '971 in view of U.S. Patent No. 6,096,027 to Layne.

Tsugita teaches the claimed invention except for the loading element. Layne teaches a prosthetic loading device that comprises a funnel in order to collapse the prosthesis into a smaller diameter suitable to fit into a delivery catheter (Column 3 lines 14-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Tsugita with a loading funnel in order to load the filter into a delivery catheter of a smaller diameter.

Allowable Subject Matter

8. Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 571-272-4691.


The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


jrb

Jessica R Baxter
Examiner
Art Unit 3731


ANH TUAN T. NGUYEN
PRIMARY EXAMINER

11/29/04